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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,727	09/10/2003	Richard E. Forkey	P25-003	3882
34021	7590	08/23/2005		
GEORGE A. HERBSTER 40 BEACH STREET SUITE 303 MANCHESTER, MA 01944			EXAMINER MACK, RICKY LEVERN	
			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No.	Applicant(s)	
	10/659,727	FORKEY ET AL.	
	Examiner	Art Unit	
	Ricky L. Mack	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 21-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0205</u> | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION***Information Disclosure Statement***

1. The DE 9200876U reference cited on information disclosure statement filed 2/8/05 was not initialed on the copy mailed 3/11/05. The DE 9200876U has been considered and is initialed on the PTO-1449 provided with this office action. Lined through references on the PTO-1449 were previously initialed on the copy mailed 3/11/05.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-12 and 15-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hasegawa (DE 4438511 A1).

Hasegawa discloses, as in claims 1, 10 and 19, an optical device extending along a geometric axis comprising: A) a final lens element (21) formed from an initial lens element characterized by centered, rotational symmetry about an optical axis, said final lens element having at least one [sawn] planar face (21a) extending between image forming surfaces transverse to said geometric axis at each end of said final lens element, said at least one [sawn] planar face being

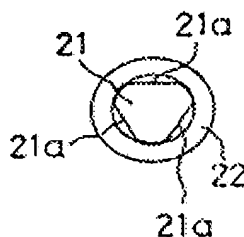
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parallel to and spaced from the geometric axis, and B) a sheath (22) surrounding said lens element.

Hasegawa discloses the claimed invention except the planar faces being formed by a sawn process.

Since applicant is claiming a device, as opposed to process, the manner in which the device is made is not patentable significance in claim 1. See MPEP 2113.

FIG. 11B



“The patentability of a product does not depend upon its method of production. If the product in [a] product-by-process claim is the same as or obvious from a product of the prior art, [then] the claim is unpatentable even though the prior [art] product was made by a different process.” In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983).

Hasegawa discloses, as in claims 2 and 11, an optical device wherein said sheath has a cylindrical cross section.

Hasegawa discloses, as in claims 3 and 12, an optical device wherein said final lens element has at least two [sawn] planar faces that lie in intersecting planes.

Hasegawa discloses, as in claims 6 and 15, an optical device formed with a geometric axis that is parallel to the optical axis in said initial lens element.

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Hasegawa discloses, as in claims 7 and 16, an optical device wherein said final lens element is inclusive of portions of said initial lens element including said optical axis.

Hasegawa discloses, as in claims 8 and 17, wherein said optical and geometric axes are parallel.

Hasegawa discloses, as in claims 9 and 18, wherein said optical and geometric axes are coincident.

Hasegawa inherently discloses, as in claim 20, a polygonal lens (see fig. 11B, ref. 21) located in a sheath (22).

Claim Rejections - 35 USC § 103

5. Claims 4, 5, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (DE 4438511 A1) in view of Mazurkewitz (6088157).

Hasegawa discloses the claimed as described above, but does not disclose an optical device having four planar surfaces whereby said final lens element has a rectangular cross section (claims 4 and 13) or a square cross section (claims 5 and 14). Hasegawa discloses a lens a triangular cross section. Within the field of endeavor, Mazurkewitz discloses an endoscope with a lens of triangular and square cross section. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the optical device of Hasegawa with lenses of triangular and square cross section, as disclosed by Mazurkewitz, for the purpose of providing a rod shaped optical element “suitable for use with the optical instrument in which it is to be used” (Mazurkewitz: col. 5, lines 3-15).

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Examiner's Comment(s)

7. Upon further consideration a previously considered reference, and in particular to a figure (11b), which reads on applicant's invention, and to a newly cited reference, the allowability of claims 10-20 has been withdrawn.

Allowable Subject Matter

8. Claims 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is an examiner's statement of reasons for allowability: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of the independent claim(s), in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in claim(s) 21-25, wherein the claimed invention comprises a step wherein sawing includes positioning the lens system with respect to a saw and whereby portions of the lens element that are removed lie outside said portions of said lens elements inclusive of the geometric and optical axes whereby the final lens assembly includes both the optical and geometric axes, as claimed. The combination of all the claimed features are not anticipated or made obvious by the prior art and all of said features are relied upon for a determination of allowability.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakamura (JP404183477A) is cited for disclosing a catheter with a rod lens (3) and light guides surrounding the rod lens. Forkey (WO 2005/026813 A1) is a related PCT document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky L. Mack whose telephone number is (571) 272-2333. The examiner can normally be reached on Monday-Friday (6:30 AM to 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ricky L Mack
Primary Examiner
Art Unit 2873

RM
August 21, 2005